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EXAMINER

ASHLEY, BOYER DOLINGER

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3724

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Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/626,193

Filing Date: 7/28/2000

Appellant(s): Glennis Orloff et al.

Wayne R. Grohs

For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 5/19/05 appealing from the Office
action mailed 12/21/04.



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(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

This appeal involves claims 64, 67-69, 85-87, and 116-118.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection is correct.

Appellant's brief presents arguments relating to the non-entry of a proposed amendment after final, which were not entered as they raised new issues requiring at least further consideration. This issue relates to petitionable subject matter under 37 CFR 1.181 and not to appealable subject matter. See MPEP § 1002 and § 1201.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

The following is a listing of the evidence (e.g., patents, publications, Official Notice, and admitted prior art) relied upon in the rejection of claims under appeal.

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| 5,100,506 | Sturtevant et al. | 3-1992 |
|-----------|-------------------|--------|

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 64, 67, and 86-87 are rejected under 35 U.S.C. 102(b) as being anticipated by Sturtevant et al., U.S. Patent 5,100,506.

Sturtevant et al. discloses the same invention as claimed including: a substantially planar and rigid substrate (53); and at least 100 micro-blades (51/57; Figure 5 show well over 100 individual cutters) capable of cutting hair.

As to claim 67, Sturtevant et al. discloses at least about 200 micro-blades (see Figure 5 which shows over 200 individual cutters and approximately 300).

As to claim 86, Sturtevant et al. discloses, as shown in Figure 5, blades arranged in ordered columns and rows.

As to claim 87, Sturtevant et al. discloses, as shown in Figure 5, blades arranged in staggered columns and rows as displayed as offset teeth.

It should be noted that the specific language "the micro-blades are configured for cutting hair when drawn across a skin surface and without damaging the skin" is merely functional/intended use recitations not defining any specific structure. In apparatus

Art Unit: 3724

claims functional/intended use language does not serve to distinguish the claimed invention from the prior art; apparatus claims must be define over the prior art in terms of structure. The only requirement is that the prior art be capable of the functional/intended use. In this case the prior art is fully capable of cutting hair not matter how poorly it may or may not perform. There is no requirement for a prior art reference to function perfectly.

Claims 68-69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sturtevant.

Sturtevant discloses the invention substantially as claimed except for the specific number of micro-blades being 500, or 1000. However, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to use any number of blades depending upon the size of the hair removal device desired and needed as well as the size of the area for hair removal in order to speed up the hair removal process, because it has been held that mere duplication of essential working parts of a device involves only routine skill in the art. Moreover, it would have been an obvious matter of design choice to use nay number of blades for the purpose of facilitating hair removal based upon the size of the work area, because applicant has not disclosed that the specific number of blades solves ay stated problem or is for any particular purpose and it appears that the invention would perform equally well with any number of blades whether 500 or 1000 depend upon the size of the workpiece.

Claim 85 is rejected under 35 U.S.C. 102(b) as anticipated by Sturtevant or, in the alternative, under 35 U.S.C. 103(a) as obvious over Sturtevant.

Sturtevant et al. discloses the same invention as claimed including each blade mounted on separate blade supports (59). In the alternative, even if it is argued that Sturtevant et al. lacks the separate blade mounts because the blades of Sturtevant et al. are integral with the substrate, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use separate blade supports for each blade in order to save time and money replacing individual blades, because it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art.

Claims 116-118 are rejected under 35 U.S.C. 102(b) as anticipated by Sturtevant or, in the alternative, under 35 U.S.C. 103(a) as obvious over Sturtevant.

As to claim 116, Sturtevant discloses the same invention as claimed including, e.g., the substrate has a generally flat upper surface as shown in Figure 5; a blade support (59) attached to the substrate and extending above the surface of the substrate, and a blade with a cutting edge (57, the outer edge) attached to the blade support elevated above the surface of the substrate, wherein the cutting edge is capable of cutting hair.

In the alternative, even if it is argued that Sturtevant lacks separately pieced together elements for the substrate, blade support, and blade because said three elements are integral, it would have been obvious to one having ordinary skill in the art

Art Unit: 3724

at the time the invention was made to use separate blade supports for each blade in order to save time and money replacing individual blades, because it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art.

As to claim 117, the blade support portion extends from the portion (59) to just before the cutting edge portion (57) and therefore is generally perpendicular to the upper surface of the substrate as it extends upperly relative to the substrate.

As to claim 118, cutting edge is generally parallel to the upper surface considering the cutting edge extends around the outer edge; moreover, column 6, lines 25-35 discloses that the cutting edge could take on different sizes and shapes, such as rounded, serrated, pointed, and etc. Therefore, the cutting edges can be generally parallel to the upper surface of the substrate.

It should be noted that the specific language "adapted in size and shape and oriented relative to the upper surface to cut hair when drawn across a skin surface and without damaging the skin surface" is merely functional/intended use recitations not defining any specific structure. In apparatus claims functional/intended use language does not serve to distinguish the claimed invention from the prior art; apparatus claims must be define over the prior art in terms of structure. The only requirement is that the prior art be capable of the functional/intended use. In this case the prior art is fully capable of cutting hair not matter how poorly it may or may not perform. There is no requirement for a prior art reference to function perfectly.

(10) Response to Argument

Appellant contends that the proposed after final amendment should have been entered because they did not raise new issues. It is the examiner's opinion that the proposed claim changes do in fact raise new issues that require at least further consideration and were properly not entered. In any event, the question of whether or not the after final should have been entered or not is a petitionable issue not an appealable issue and therefore, not germane to current appealed claims. However, the examiner will offer the following brief response to Appellant's comments.

Appellant contends that the proposed after final amendments to claim 64 do not raise new issues because the proposed claim language already existed in claim 116. However, the examiner respectfully disagrees. Although, the proposed language is in claim 116, the metes and bounds of claim 64 are not the same as claim 116. The proposed claim language was never considered in combination with at least 100 micro-blades as found in claim 64 nor was the proposed claim language in combination with dependent claims 67, 68, 69 ever considered. Appellant further contends that they intended to include the phrase "said cutting edge ... edge support surface" to address the examiner's comments address the intended use of the structure. It should be noted that no such amendment using the exact phrase was proposed. The Appellant believes that adding the above phrase obviates the examiner's concerns regarding the intended use of the device. Moreover, Appellant contends that specification supports these changes. The examiner does not disagree with Appellants in that the specification supports such changes. However, entry of amendments after final rejections are not

Art Unit: 3724

made as a matter of right. Moreover, it is not clear if such a change would obviate the examiner's concerns because the examiner was never given an opportunity to consider them.

As to Appellant specific arguments regarding the art rejections, the examiner would like to point the Board to the previous responses in the Final rejection dated 12/15/04, as current arguments are similar regarding the intended use of the claimed device.

Appellant contends that Sturtevant fails to disclose, teach, or suggest a hair removal device having a planar substrate and micro-blades connected to the substrate because the term "micro-blade" is defined in the specification as having a specific structure. Although, it is true that one must look to the specification for understand of the claim language there is no requirement for one incorporate structure from the specification into the claims. Nothing in the term "micro-blades" connotes any specific definition nor do the claims suggest any specific structure. Why would someone need to look to the specification for the term "micro-blade"? The term "micro" just means "small" therefore, at most the phrase implies a small blade. As outlined in 2111 of the MPEP it is a long standing practice to interpret claims with their broadest reasonable interpretation as well as given terms there plain meaning (MPEP 2111.01). Section II of MPEP 2111.01 states that the plain meaning refers to the ordinary and customary meaning given to the term by those of ordinary skill in the art. How are the claims limited to the structure provided in the specification? There is no structure in Sturtevant or Appellant's disclosure that prohibits calling the structure in Sturtevant a "micro-blade".

As to the intended use of the claims, that is, "a hair removal device" and "wherein the micro-blades are configured for cutting hair when drawn across a skin surface and without damaging the skin" it should be noted that Sturtevant is fully capable of removing hair without damaging skin depending upon how the user presses the tool against the hair to be remove. Sturtevant discloses a tool with multiple cutting edges for removing wood such as in a planing operation. If the cutting edges of Sturtevant are sharp enough to cut wood then they are more than capable of cutting hair, which has a structural strength less than wood. Furthermore, the claims are not restricted any specific type of hair or skin surface, is this of a human or that of animal hide. Appellant contends that even if the device is used to remove hair it couldn't do so without removing skin. However, the examiner respectfully disagrees as it would depend upon how the tool was used, e.g., how close the tool has held to the skin surface, how hard and fast the tool was moved relative to the skin surface. There is no requirement for the tool to be placed against the skin surface of a user during operation. It should be noted that there is no requirement under 35 USC 102 for prior art devices to function perfectly or flawlessly or for the same reasons as Appellant's device. Furthermore, it is not completely clear what the phrase "without damaging the skin" encompasses. There are many devices sold today for exfoliating skin by using abrasives surfaces. These surfaces clearly roughen the surface of the skin but are they "damaging the skin"? If the user of the Sturtevant lightly pressed the device against the a users skin surface certainly no more "damage" to the skin would be caused then by the exfoliating skin.

Art Unit: 3724

Appellant contends that rejection of claims 68, 69, 85, and 116-118 under 35 USC 103(a) is improper because Sturtevant is non-analogous art because it is not in the same field of endeavor or at least be reasonably pertinent to the particular problem with which the invention is concerned. However, the examiner respectfully disagrees.

Sturtevant is in a similar field of cutting and is reasonably pertinent because the claims merely recite the structure of a substrate and a specific number of micro-blades (claims 64, 67, 68, 69). Only claims 85-87 and 116-118 recite any additional structure but nothing that takes claim device in any specific field. In other words, the claims are so broad that to place the device in any specific field would be to unfairly restrict the claimed subject matter.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


BDA

8/2/05

Conferees:


Dennis Banks


Allan Shoap